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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
09 211,715	12 14 1998	FAHAD AL-OBEIDI	P-SE-3243	9543

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EXAMINER

LIU, SAMUEL W

ART UNIT PAPER NUMBER

1653

DATE MAILED: 07 02 2003

28

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/211,715

Applicant(s)

AL-OBEIDI ET AL.

Examiner

Samuel W Liu

Art Unit

1653

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 09 May 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 7-10, 2-23 and 25.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 11.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

Continuation of 5. does NOT place the application in condition for allowance because: The examiner acknowledges receipt of the after final amendment filed 9 May 2003 (Paper No.26). Applicants' cancellation of claims 2 and 3, and amendment of claims 8-11, 20 and 25 have been entered. The terminal disclaimer filed 9 May 2003 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Pat. No. 5849510 has been reviewed and is accepted. The terminal disclaimer has been recorded. Also, Applicants' petition for extension of time of three months filed 9 May 2003 (Paper No. 25) has been entered.

The claim rejections under 35 USC 112, the first paragraph, and rejections under 35 USC 102(e) are withdrawn because applicants cancel claims 2 and 3 to which the rejections are directed. The rejection obviousness-type Double Patenting (ODP) in the previous Office action mailed 20 November 2002 is also withdrawn in light of the above mentioned terminal disclaimer. Claims 7-10, 20-23 and 25 are allowable because the claims are free of the recited prior art. However, the claims rejection under 35 USC 112, the second paragraph as to the recitation "Arg-OH" in claim 11 is maintained because of the reason set forth in the previous Office action (Paper No. 24). In the response filed 9 May 2003 (Paper No.26), applicants assert that amino acid residue-OH, Leu-OH, is clear to one skilled in the art as a notion used to emphasize that the C-terminus of the residue is not modified (see page 16). The applicants' argument is not persuasive because the specification does not define the stated notion, and because unmodified residue at C-terminus should be either identified as an amino acid residue without "-OH" group, or a C-terminal residue with "-COOH" rather than "-OH" as free carboxyl group indicates unmodified the C-terminus thereof.



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PRIMARY EXAMINER